

AMENDMENT UNDER 37 C.F.R. § 1.111
U.S. APPLN. NO. 09/787,706

REMARKS

Applicant respectfully traverses the rejection of claims 1, 3, 4 and 6 under 35 U.S.C. § 102(b) as being anticipated by Goldenberg, the rejection of claim 2 under 35 U.S.C. § 103(a) as being unpatenable (obvious) over Goldenberg in view of Masuda, the rejection of claim 5 under 35 U.S.C. § 103(a) as being unpatenable (obvious) over Goldenberg, the rejection of claim 7 under 35 U.S.C. § 103(a) as being unpatentable (obvious) over Goldenberg in view of Pauli, and the rejection of claims 8-12 under 35 U.S.C. § 103(a) as being unpatentable (obvious) over Goldenberg in view of Bouchet.

Applicant respectfully submits that the Examiner's rejections are based on a misinterpretation of Goldenberg's disclosure.

First, the new independent claim 13 comprises features substantially similar to those of claims 1 and 3 and further recites that each of the first and second cases is individually sealed, as described in the specification on page 2, lines 30-31. Dependent claim 14 corresponds to original claim 2. Therefore, **new claims 13 and 14 are allowable** for the same reasons that claims 1 and 3 are allowable, and also for the further limitations recited in these new claims.

The new independent claim 15 recites features substantially similar to those of claims 1 and 6 and further recites that each of the first and second cases is individually sealed, as described in the specification on page 2, lines 30-31. Dependent claims 16-21 correspond to original claims 7-12, respectively. Therefore, **new claims 15-21 are allowable** for the same

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reasons that claims 6 (6/1) and 7-12 are allowable, and also for the further limitations recited in these new claims.

Claim rejections under 35 USC § 102

Claims 1, 3, 4 and 6 have been rejected under 35 USC § 102(b) as being "anticipated" by US Patent 5,479,381 to Goldenberg. Applicant respectfully submits that this rejection is not correct because Goldenberg fails to disclose, either expressly or inherently, all of the limitations recited in claims 1, 3, 4 and/or 6, as is required for a rejection based on anticipation; that is, these claims are not readable on Goldenberg (when properly interpreted). (Goldenberg is **cited and distinguished** in Applicant's specification at page 1, lines 30-35.)

It is correct that Goldenberg discloses a reversible timepiece such as a wristwatch, comprising two opposite **faces** 20 and 30 each including a separate watch movement 22 and 32, respectively, said movements controlling two respective displays and being mounted in a back-to-back arrangement to form an assembly that is attached to the opposite ends of a flexible watchband 50.

However, Goldenberg does not disclose (or suggest) the "in a **removable** manner" limitation, and Goldenberg's disclosure is **unclear and non-enabling** on several points regarding the structure of the case of the reversible watch. On one hand, only a **single** watch **case** appears in the general views of Figs. 1-3; this "**case**" is mentioned in the specification only in column 3, lines 33-34, namely as a **single** case. On the other hand, Figs. 4 and 5, showing the two movements and faces of the timepiece, could be interpreted as showing two case portions each

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having identical pairs of horns. However, there is no description of means for securing said case portions to each other. The portions might be glued to each other. If the watch case actually had two such portions, a separation line between these portions should be visible in Figs. 1-3. Furthermore, since the watch movements 22 and 32 are visible in Fig. 5 (see column 2, lines 51-56), it is clear that these case portions have no back covers. Finally, when one considers the configuration of the horns shown in Figs. 4 and 5, one **cannot** understand how these horns could be combined to form the horns shown in Figs. 1-3. Anyway, the pairs of horns could **not** be connected to each other by a bar as specified in Applicant's claim 3. **N.B.** It is well established that a reference, to be viable, must, itself, contain an **enabling** disclosure for what the reference purports to teach.

As explained in Applicant's specification on page 2, lines 28-34, the basic concept of the present invention is to form a reversible wristwatch by assembling, in a removable manner, two complete watch cases of a common type, in particular waterproof sealed cases, in a back-to-back relationship such that their respective back covers are adjacent to each other. The Goldenberg reference fails to anticipate such concept since it **fails to disclose** two cases each having a back cover, and any "securing element" for **removably** securing the cases to each other.

Hence claim 1 and its dependent claims 3, 4 and 6 are clearly novel over (i.e., are not readable on) Goldenberg's disclosure.

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Claim rejections under USC 35 § 103

According to claim 2, “each case of the reversible watch contains an electric battery and includes a battery hatch provided with a removable cover in its back cover”. The result is that these hatches and covers are concealed when both case are secured in their normal back-to-back position, but are readily accessible when the cases are separated (see the paragraph bridging pages 6 and 7 in the specification).

As explained above, Goldenberg fails to disclose use of two watch cases, each having a back cover, and means for removably securing the cases to each other, as claimed in claim 1, and further fails to disclose the features of claim 2.

Masuda does not even address the structure of a reversible watch and, hence, understandably does not provide any specific teaching in this regard. Applicant acknowledges that Masuda discloses a wristwatch comprising a first case and a second case that is movably mounted on the first case, each case containing its own battery 22, 25. However, Masuda, like Goldenberg, fails to disclose that both cases, when placed in superposed relationship, have adjacent back covers, and that each of the back covers has a battery hatch and a removable cover on the hatch. Obviously, as shown in Figs. 3, 5 and 8 of Masuda, battery 25 of the lower case 2 can be replaced **only** by opening the bottom plate 2b which lies on the side opposite to the upper case 2.

Hence, **no** combination, whether obvious or not, of the cited references would suggest or produce the combination of features of claims 1 and 2 (2/1).

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The Examiner's rejection of claim 5 over Goldenberg is flawed in that it refers to "the horn assembly used by Goldenberg" (e.g., on page 4, lines 4-5, of the Office Action). However, Goldenberg does **not disclose** such an "assembly". Hence, the specific structure recited in claim 5 would not have been obvious from, and cannot be considered as an alternative to, Goldenberg's disclosed structure.

The Examiner has made the same misinterpretation regarding claim 7 (dependent on claim 6, which should be **allowable**), because Goldenberg does **not disclose** any means for securing one case portion to the other, and, moreover, does **not disclose** cases each having a back cover. Furthermore, the secondary reference, Pauli, fails to disclose any "securing elements" on the back cover of a watch case. Thus, **no** combination of the teachings of these two references would suggest or produce the combination of features recited in Applicant's claim 7 (7/6/1).

Claim 8 (8/1) and its dependent claims have been rejected as being unpatentable (obvious) over Goldenberg in view of Bouchet. Claim 8 substantially defines an embodiment wherein the assembly formed of two cases, as defined in claim 1, can be reversed by pivoting and sliding on two parallel bars of a support secured to a wristband. Thus, both ends of the wristband are connected to each other through the rigid support and **not** through the mobile watch case.

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Clearly, then, Goldenberg does not disclose or suggest all the features of the parent claim 1, in particular the combination of two watch cases having back covers adjacent to each other. Goldenberg also fails to disclose the features of dependent claim 8.

Furthermore, Bouchet describes a reversible wristwatch having a single case with two faces. As explained in column 2, lines 1-22, each end of the watch case is pivotally mounted on a respective bar 2, 3 intended to be connected to a corresponding end of a strap. Bars 2 and 3 are connected to each other **only** by the flexible strap and **cannot** be compared to Applicant's claimed "support". Each bar can pivot on the case independently from the other bar. Furthermore, Bouchet does not at all suggest that the case might slide on the bars, a movement that is **impossible** in the context of Bouchet's disclosure. The Examiner's assertions (on page 5, last paragraph) regarding a sliding movement in Bouchet are simply **unsupportable**.

Hence, neither Goldenberg nor Bouchet, alone or in combination, teaches or suggests that the reversible assembly of two cases could pivot and slide on a "support" connecting both ends of the wristband according to claim 8, and furthermore according to the dependent claims 9-12.

In summary, Applicant respectfully requests the Examiner to reconsider and withdraw the prior art rejections of claims 1-12, and to find the application to be in condition for allowance with all of claims 1-21 for the reasons presented above.

REQUEST FOR INTERVIEW

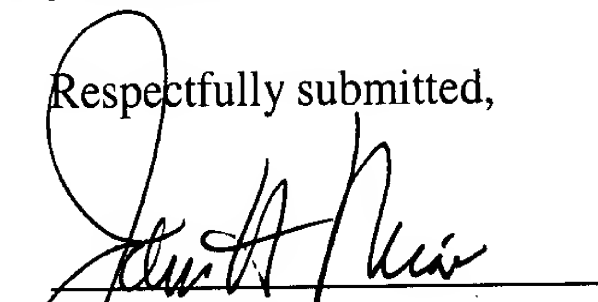
However, if for any reason the Examiner feels that the application is not now in condition for allowance, the Examiner is respectfully requested to **call the undersigned Attorney** to

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discuss any unresolved issues (especially, if necessary, the interpretation of Goldenberg's disclosure) and to expedite the disposition of the application.

Applicant files concurrently herewith an Excess Claim Fee Payment Letter (with fee) and a Petition (with fee) for an Extension of Time of two (2) months. The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,


John H. Mion
Registration No. 18,879

SUGHRUE MION, PLLC
Telephone: (202) 293-7060
Facsimile: (202) 293-7860

WASHINGTON OFFICE



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